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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
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11 *Ex parte* EDWARD HUBERTUS PAPROTNA and DAVID A. LITTLE
12

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14 Appeal 2008-4094
15 Application 10/774,907
16 Technology Center 3600
17

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19 Decided: October 27, 2008
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22 *Before:* WILLIAM F. PATE, III, JENNIFER D. BAHR, and
23 FRED A. SILVERBERG, *Administrative Patent Judges*.
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25 SILVERBERG, *Administrative Patent Judge*.
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28 DECISION ON APPEAL
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31 STATEMENT OF THE CASE

32 Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Office
33 Action of claims 1, 3, 4, 6 and 7. We have jurisdiction under 35 U.S.C.
34 § 6(b) (2002).
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37 SUMMARY OF DECISION

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39 We AFFIRM-IN-PART.

THE INVENTION

The appellants claimed invention is directed to a seal usable between two thermally movable components such as those found in turbine engines. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A seal usable between two thermally movable components, comprising:
 - a body for sealing space between adjacent components to prevent a fluid from passing through the space;
 - wherein the body has a cross-section that has a first side, a second side generally opposite to the first side, a first end, and a second end generally opposite to the first end, wherein the first and second sides have lengths longer than lengths of the first and second ends;
 - wherein the first end includes at least one first tooth extending from a region on the first end proximate to an intersection between the first end and the first side and extending toward the second side of the body and at least one second tooth extending from a region on the first end proximate to an intersection between the first end and the second side and extending toward the first side of the body

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Hertz, Jr.	US 4,524,981	Jun. 25, 1985
Milazar	US 5,975,844	Nov. 2, 1999

The following rejections are before us for review:

1. Claim 1 is rejected under 35 U.S.C. § 102(b) (2002) as being as being anticipated by Hertz, Jr.
2. Claims 1, 3, 6, and 7 are rejected under 35 U.S.C. § 102(b) (2002) as being anticipated by Milazar.

3. Claims 3, and 4 are rejected under 35 U.S.C. § 103(a) (2004) as being unpatentable over Hertz, Jr.

4. Claim 4 is rejected under 35 U.S.C. § 103(a) (2004) as being unpatentable over Milazar.

ISSUES

The issues before us are whether the Appellants have shown that the Examiner erred in rejecting claims 1, 3, and 4 over Hertz, Jr., and claims 1, 3, 4, 6, and 7 over Milazar. These issues turn on whether: (1) Hertz, Jr. discloses at least a first tooth extending from a region on the first end as recited in claim 1; and (2) Milazar discloses at least a first tooth extending from a region on the first end proximate to an intersection between the first end and the first side and extending toward the second side, wherein the first and second sides have lengths longer than lengths of the first and second ends as recited in claim 1.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Appellants' Specification discloses that a first end 24 includes at least one first tooth 36 extending from an upper region 42 on the first end 24 proximate to an intersection 44 between the first end 24 and a first side 20 and extending toward a second side 22 of the body 16, and at least one second tooth 36 extending from a lower

- 1 region 46 on the first end 24 proximate to an intersection 48
2 between the first end 24 and the second side 22 and extending
3 toward the first side 20 of the body 16 (Spec. p. 6, ll. 7-19).
- 4 2. Hertz, Jr. discloses a seal 20 including a cut 30, which comprises a
5 pair of grooves (34a and 34b), wherein a first end (end near 12) has
6 a first tooth (element above groove 34a) extending from a region
7 on the first end proximate to an intersection between the first end
8 and a first side (top side adjacent to 16 in Fig. 1) and extending
9 toward a second side (bottom side adjacent to 18 in Fig. 1), and the
10 first end has a second tooth (element below groove 34b) extending
11 from a region on the first end proximate to an intersection between
12 the first end and the second side and extending toward the first side
13 of the body (Hertz, Jr., Figs. 2 and 3).
- 14 3. Milazar discloses a seal wherein a first end 9a has at least one
15 tooth 20 (tooth at 6b) extending from a region on the first end
16 proximate to an intersection between the first end and a first side
17 6b and extending toward a second side 6a, and the first end has at
18 least a second tooth 20 (tooth at 6a) extending from a region on the
19 first end proximate to an intersection between the first end and the
20 second side and extending toward the first side of the body
21 (Milazar, Fig. 2).
- 22 4. The Appellants' Drawings disclose a seal wherein the first sides 20
23 and second sides 22 have lengths longer than lengths of the first
24 ends 24 and second ends 26 (Fig. 5).
- 25 5. Hertz, Jr.'s seal's first and second sides have lengths longer than
26 lengths of the first and second ends (Figs. 2-3).

6. Milazar's seal's first and second sides have lengths shorter than the lengths of the first and second ends (Fig. 2).

PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

When construing claim terminology in the Patent and Trademark Office, this Board is required to give the claim language its broadest reasonable interpretation. *See In re Crish* 393 F.3d, 1253, 1256 (Fed. Cir. 2004); *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). *In re Hyatt*, 211 F.3d 1367, 1372-73 (Fed. Cir. 2003).

ANALYSIS

In contesting the rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Hertz, Jr., Appellants simply rely on the arguments made with respect to the rejection of claim 1 under 35 U.S.C. 102(b) as being as being anticipated by Hertz, Jr. In contesting the rejection

of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Milazar,
Appellants simply rely on the arguments made with respect to the rejection
of claim 1 under 35 U.S.C. 102(b) as being as being anticipated by Milazar.

*Rejection of claim 1 under 35 U.S.C. 102(b) as being as being anticipated by
Hertz, Jr.*

Appellants argue that the claimed seal includes at least one tooth that
extends from a first end. Appellants further argue that while Hertz, Jr.
discloses an annular seal with grooves cut into inner and outer sealing
surfaces; it does not disclose a seal with teeth extending from an end of the
seal (Br. 9, and 10). The Examiner stated that Hertz, Jr. discloses all of the
features called for in claim 1 (Ans. 5, and 6). In the Examiner's Answer, the
Examiner inserted a copy of Figure 1 of Hertz, Jr., wherein the elements of
Hertz, Jr. are labeled as the limitations are read on them as called for in
claim 1 (Ans. 6).

We note that in Hertz, Jr., the seal 20 includes teeth extending in the
orientation called for in claim 1 (Fact 2). As such, we find that the Examiner
correctly concluded that Hertz, Jr. does, in fact, disclose a seal with teeth
extending from an end of the seal as called for in claim 1.

*Rejection of claims 1, 3, 6, and 7 under 35 U.S.C. § 102(b) as being
anticipated by Milazar; and claim 4 under 35 U.S.C. § 103(a) as being
unpatentable over Milazar.*

Appellants argue that the claimed seal comprises first and second
sides having lengths longer than the lengths of the first and second ends,
wherein the teeth are on the first end that is shorter than the first and second

sides, while Milazar does not disclose teeth extending from a first end of a seal body that is shorter than the first and second sides of the seal body (Br. 10). The Examiner stated that Milazar discloses the claimed teeth limitations. In the Examiner's Answer, the Examiner inserted a copy of Figure 2 of Milazar, wherein the elements of Milazar are labeled as they are being read on the limitations called for in claim 1 (Ans. 6).

We find that the Examiner's explanation of how the elements of Milazar read on claim 1 (Ans. 3, and 4) and the inserted copy of Figure 2 of Milazar containing labeled elements (Ans. 6) are inconsistent, as the elements denoted as being the sides and the ends in the inserted copy of Figure 2 are reversed from the detailed explanation set forth on pages 3 and 4 in the Examiner's Answer. Further, we find that the teeth of Milazar extend out from the long end of the seal body, and as such Milazar does not disclose teeth extending from a first end of a seal body that is shorter than the first and second sides of the seal body (Fact 6).

Rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Hertz, Jr.

Appellants' argument regarding the rejection of claims 3 and 4 as being unpatentable over Hertz, Jr. is not persuasive for the reasons set forth above in our discussion of the rejection of claim 1 as being anticipated by Hertz, Jr.

CONCLUSION OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) as being anticipated by

Hertz, Jr., and claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Hertz, Jr. We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1, 3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Milazar, and claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Milazar.

DECISION

The decision of the Examiner to reject claims 1, 3, and 4 over Hertz, Jr. is affirmed. The decision of the Examiner to reject claims 1, 3, 4, 6, and 7 over Milazar is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

vsh

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN NJ 08830